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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,999	08/18/2003	Oliviero Dolci	SAIC 20.557 (100788-00064)	2966
26304 7590 02/01/2007 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER ROSS, DANA	
			ART UNIT 3722	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/642,999

Applicant(s)

DOLCI ET AL.

Examiner

Dana Ross

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/18/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 21 and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Dolci et al. ('508).

Dolci et al. disclose a book comprising a plurality of book sections bound together, each of the plurality of book sections being adjacent to another of the plurality of book sections and having a shape unique to that book section so that the plurality of book sections forms subject in relief (as seen in figure 5); a first plurality of pages (2) having a first page type and at least one page of the first plurality of pages being disposed in each of the plurality of book sections (Dolci et al. disclose the pages being made of paperboard, thin card, plastic, wood or other similar material - see column 1, lines 12-18) and a second plurality of pages (2) having a second page type and at least one page of the second plurality of pages being disposed in each of the plurality of book sections (Dolci et al. disclose the pages being made of paperboard, thin card, plastic, wood or other similar material - see column 1, lines 12-18); wherein when the book is closed figures are reproduced in positions such as to form an index of the subject which is formed in relief by the plurality of book sections (as seen in figure 5).

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-20 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolci et al. ('508) in view of Wolski (4,819,963).

Dolci et al. disclose a book comprising a plurality of book sections bound together, each of the plurality of book sections being adjacent to another of the plurality of book sections and having a shape unique to that book section so that the plurality of book sections forms subject in relief (as seen in figure 5); a first plurality of pages (2) having a first page type and at least one page of the first plurality of pages being disposed in each of the plurality of book sections (Dolci et al. disclose the pages being made of paperboard, thin card, plastic, wood or other similar material - see column 1, lines 12-18) and a second plurality of pages (2) having a second page type and at least one page of the second plurality of pages being disposed in each of the plurality of book sections (Dolci et al. disclose the pages being made of paperboard, thin card, plastic, wood or other similar material - see column 1, lines 12-18).

Dolci et al. disclose the claimed invention except for explicitly disclosing the first plurality of pages having a thickness greater than the second plurality of pages.

Wolski discloses a book structure comprising a three-dimensional structure in the form of a toy fish (2), where the sculpture is divided into first (4) and second (6) halves and including a plurality of bound sheets (8) therebetween. Wolski discloses that the sculpture may be formed of

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materials “which are resistant to breakage, water, dirt and grease, and which will even be capable of being cleaned and/or immersed in water. Therefore some materials of choice for such sculptures will include plastic or wood. Another useful material, which has benefit of being inexpensive and easily produced is paper mache’ including a plaster-of-paris base. Of course, any other suitable material can be used to form the sculpture.” Wolski further discloses the pages being composed of any substantially flat printable material, including, for example paper, from ordinary weight to heavy cardboard, and even wood, in some embodiments of the device. Also, water resistant plastic materials and plastic impregnated cloth materials may be used to form the sheets or pages” (see col. 5, lines 19-54).

Wolski teaches that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired material for the pages as deemed necessary by the end user. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

As seen in figure 4, the thickness of the first and second halves of the sculpture formed of a desired material is greater than the thickness of the pages located between the first and second halves of the sculpture and formed of a desired material. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the first and second pages of Dolci et al. to include different thickness, as taught by Wolski, to provide a book that is relatively light weight yet durable enough for use by children as toys.

Regarding claims 12 and 14, Dolci et al., as modified by Wolski, disclose the pages of the book and the book cover being made of paperboard, thin card, plastic, wood, paper or other similar material (see column 1, lines 12-18 of Dolci et al. and col. 5, lines 19-54 of Wolski).

Regarding claim 15, Dolci et al., as modified by Wolski, disclose a first one of the plurality of book sections (2) being more proximal to the front cover (7) and a second one of the plurality of the book sections (2) being more distal from the front cover (as seen in figure 5 of Dolci et al.).

Regarding claim 16, a planar profile of the first one of the plurality of book sections (2 – closest to front cover 7) does not protrude beyond a planar profile of the second one of the plurality of book sections (2 – adjacent to the aforementioned book section) (as seen in figure 5 of Dolci et al.).

Regarding claims 17 and 18, Dolci et al., as modified by Wolski, disclose each of the shapes of the book sections comprise a first substantially straight edge portion for binding the book sections together (the straight edge portion being along the binding region 3 of Dolci et al.); wherein each of the shapes of the book sections is formed so that the book remains in equilibrium on a flat surface (second straight edge) which is substantially perpendicular to the first edge portion (as seen in figure 6 of Dolci et al.).

Regarding claim 19, Dolci et al., as modified by Wolski, disclose a first page of one of the plurality of pages comprises the front cover (7) and a last page of one of the plurality of pages comprises the rear cover (8) (as seen in figure 5 of Dolci et al.).

Regarding claim 20, Dolci et al., as modified by Wolski, disclose that when the book is closed, figures are reproduced in positions such as to form an image of the subject which is formed in relief by the plurality of book sections (as seen in figure 5).

Regarding claims 22 and 24, Dolci et al., as modified by Wolski, disclose each plurality of book sections comprising one page of the first plurality of pages and at least two pages of the second plurality of pages. As seen in figure 4 of Wolski, the thickness of the first and second halves of the sculpture formed of a desired material is greater than the thickness of the pages located between the first and second halves of the sculpture and formed of a desired material. The first and second halves of the sculpture of Wolski correspond to the front and back covers of the different sections of the book of Dolci et al. The enclosed pages of Wolski correspond to the enclosed pages of Dolci et al. The book of Dolci et al., as modified by Wolski, would, therefore, include two pages (front and back covers) of the first plurality of pages and at least two (enclosed pages) of the second plurality of pages.

Regarding claims 23, 25 and 26, Dolci et al., as modified by Wolski, disclose the pages of the book and the book cover being made of paperboard, thin card, plastic, wood, paper or other similar material (see column 1, lines 12-18 of Dolci et al. and col. 5, lines 19-54 of Wolski).

#### ***Response to Arguments***

5. Applicant's arguments filed 21 December 2005 have been fully considered but they are not persuasive.

Applicant asserts on Page 5 of the response, and in two Declarations, that the cited prior art '508 does not teach two different page types, but instead teaches "alternative materials for use in pages". These arguments and declarations were not persuasive.

Examiner notes that the use of alternative materials is a "page type". The term "type" is a relative term and would encompass a type of material for use with paper.

Applicant asserts that a page is defined as a "thin sheet". Examiner notes that the term "thin" is a relative term.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

Examiner recommends providing limitations that positively limit the structure of Applicant's invention over the prior art.

Applicant asserts on Page 6 that Wolski does not "teach, disclose or suggest that the cover is a page as presently claimed".

Examiner notes that Wolski was used to teach the well known feature in the art of providing pages of varying materials. Wolski teaches it is well known to provide any desired material or thickness for the pages.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after



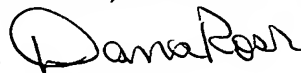
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Ross whose telephone number is 571-272-4480. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571-272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dana Ross  
Examiner  
Art Unit 3722

  
dmr